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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/049,747	01/31/2002	Ernst Rudolf F. Gesing	Mo6920/LeA 33,917	5998

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EXAMINER

FORD, JOHN M

ART UNIT	PAPER NUMBER
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1624

DATE MAILED: 04/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/049747

Applicant(s)

Gesing et al

Examiner

J.M. Ford

Group Art Unit

1624

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ONE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- ☐ Responsive to communication(s) filed on _____
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1--7 and 9 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☐ Claim(s) _____ is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☒ Claim(s) 1--7 and 9 are subject to restriction or election requirement

Application Papers

- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).

☒ All ☐ Some* ☐ None of the:

- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. _____

☒ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

Office Action Summary

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The claims in the application, as a result of the preliminary amendment of January 31, 2002, are claims 1--7 and 9.

This application has been found to contain more than one invention. Therefore, restriction to one of the following distinct inventions is required:

Group I, the instance in claims 1--5 where A is N, the triazines in class 544- subs 180 (+) depending on substitution,

Group II, the instances in claims 1--5 where A is -CH, the pyrimidines, in class 544- subs. 310+.

These distinct inventions have acquired separate status in the art, will support separate patents, and will require different fields of search for the respective inventions. Accordingly, restriction for examination purposes, as indicated, is considered proper; 37 CFR 1.145.

This is a 371 application.

Please insert on page 1 of the specification, after the title: ~~This~~ is a 371 of PCT/EP00/07096, filed July 25, 2000.

Restriction in 371 application ₅ is controlled by 37 CFR 1.475 and PCT Rule 13.2.

These provide for one compound invention (here we have two), plus one process of making the elected compound invention, plus one method using the elected compound invention.

Claim 1 constitutes an improper joinder of inventions as it groups together compound inventions that are distinct and separately classified, and will support separate patents. Ex parte Markush, 1925 C.D. 126, provided for this claim structure where there was an emergency

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engendered need, as the substances were "so closely related that they would not support a series of patents". This is not the case here. Therefore, the instant generic claims constitute an improper joinder of inventions; *Ex parte Reid*, 105 U.S.P.Q. 251; *In re Winnek*, 73 U.S.P.Q. 225; *In re Ruzicka*, 66 U.S.P.Q. 226.

A reference to a triazine would not be a reference to a pyrimidine, and vice versa. These are independent and distinct compound inventions, that will support separate patents.

The Examiner is not given the time to search more than one compound invention per application.

Applicants would not acquiesce in the rejection of one set of compounds, as Grouped, over the other.

Claims 7 and 9 are considered the one method of use, and will be examined with which ~~over~~ compound invention^{is} elected, to the extent they read on the elected subject matter.

Claim 6 was not included in the above, and is it's own Group III, as it is not limited to one invention. Claim 6 is directed to at least 4 processes. If applicants wish to have a process of making examined with the compound invention, it should be presented at the end of prosecution and limited to one process of making the elected compounds, only, as the process will only be rejoined if it is of the same scope as the final version of the compound claim ~~to~~ be allowed.

This application has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicants' cooperation is, therefore, requested in promptly correcting any errors of which they may become aware in the specification.

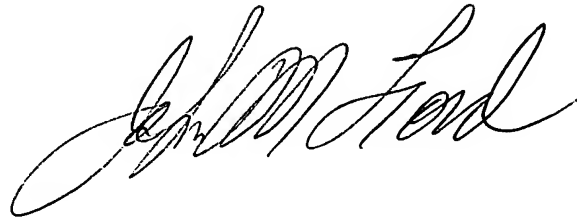
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Applicants' response must include a provisional election, even if the requirement be traversed, see 37 CFR 1.499.

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

John M. Ford:jmr

April 24, 2003

A handwritten signature in cursive script, appearing to read "John M. Ford".

**JOHN M. FORD
PRIMARY EXAMINER**

A handwritten signature in cursive script, appearing to read "Greg A. D. Unit 1624".